

## REMARKS

Claims 1 - 8, 10 - 17 and 19 - 23 are pending in this application. By this amendment, claims 1, 3, 5, 10, 12, 14, 19, 21 and 23 have been amended. It is respectfully requested that the Examiner consider the following remarks.

In the Office Action mailed September 25, 2003, the Examiner rejected claims 1-6, 8, 10-15, 17, and 19-23 under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,297,677 to Ang, et al., and rejected claims 7 and 16 under 35 U.S.C. § 103(a) as being unpatentable over Ang. It is noted that claims 1, 3, 5, 10, 12, 14, 19, 21, and 23 have been amended. To the extent that the rejections remain applicable to the currently pending claims, the Applicant hereby traverses the rejections, as follows.

With regard to claim 1, the Examiner states in the Office Action that “Ang discloses a termination resistor circuit (FIG. 16)” having “a first termination resistor block (FETs 1610 and 1630) having a first diode connected transistor 1610 and a second not-diode connected second transistor 1630; a second terminal resistor block (FETs 1630 and 1620) having the second transistor 1630 and a third transistor 1620 which is not a diode connected transistor” wherein “the blocks are connected at terminals (drain and source, as shown) of the second transistor 1630”. (See Office Action text spanning pages 2-3). Further, Ang discloses that “each PFET transistor 1620 [i.e., third transistor] becomes ‘cut-off’ when the output voltage at node cb\_s<8:1> 226 drops below  $V_{th}$ ” (col. 15, lns. 57-59) and “[the diode-connected NMOS transistors 1610, i.e., first transistor] also cuts [sic] off

when the output voltage at node cb\_s<8:1> 226 drops below  $V_{th}$ ” (col. 16, lns. 2-3).

It is respectfully submitted that the cited prior art does not disclose or suggest at least the limitation of the termination resistor circuit being switched between the first termination resistor block and the second termination resistor block by switching between the first transistor and the third transistor, as claimed in claim 1, as amended.

For at least this reason, it is submitted that claim 1 is allowable over the cited prior art. As claim 1 is allowable, it is submitted that claim 2, which depends from allowable claim 1, is likewise allowable.

For similar reasons to those discussed regarding claim 1, it is submitted that amended claims 3, 5, 10, 12, 14, 19, 21, and 23 are each allowable over the cited prior art. As claim 3 is allowable, it is submitted that claims 4 and 6-8, which each depend from allowable claim 3, are likewise allowable. As claim 10 is allowable, it is submitted that claim 11, which depends from allowable claim 10, is likewise allowable. As claim 12 is allowable, it is submitted that claims 13 and 15-17, which each depend from allowable claim 12, are likewise allowable. As claim 19 is allowable, it is submitted that claim 20, which depends from allowable claim 19, is likewise allowable. As claim 21 is allowable, it is submitted that claim 22, which depends from allowable claim 21, is likewise allowable.

With regard to each of the rejection under §103 in the Office Action, it is also respectfully submitted that the Examiner has not yet set forth a *prima facie*

case of obviousness. The PTO has the burden under §103 to establish a *prima facie* case of obviousness. In re Fine, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). Both the case law of the Federal Circuit and the PTO itself have made clear that where a modification must be made to the prior art to reject or invalidate a claim under §103, there must be a showing of proper motivation to do so. The mere fact that a prior art reference could arguably be modified to meet the claim is insufficient to establish obviousness. The PTO can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. Id. In order to establish obviousness, there must be a suggestion or motivation in the reference to do so. See also In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) (prior art could not be turned upside down without motivation to do so); In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999); In re Lee, 277 F.3d 1338 (Fed. Cir. 2002).

In the Office Action, the Examiner speculatively states that it would have been obvious to modify the prior art to render the present invention unpatentable under conditions as claimed in the present invention. See, e.g., Office Action at page 5. This is an insufficient showing of motivation.

For all of the above reasons, it is respectfully submitted that the claims now pending patentability distinguish the present invention from the cited references.

Accordingly, reconsideration and withdrawal of the outstanding rejections and an issuance of a Notice of Allowance are earnestly solicited.

Should the Examiner determine that any further action is necessary to place this application into better form, the Examiner is encouraged to telephone the undersigned representative at the number listed below.

In the event that any fees are due with respect to this paper, please charge Deposit Account No. 01-2300.

Respectfully submitted,

ARENT FOX KINTNER PLOTKIN & KAHN, PLLC

A handwritten signature in black ink, appearing to read 'W. Chesser', written in a cursive style.

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